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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

RSW920000102US1

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on March 20, 2006Signature *Dell Whitton*Typed or printed name Dell Whitton

Application Number

09/758,112

Filed

01/03/2001

First Named Inventor

Boubez et al.

Art Unit

3624

Examiner

Lalita M. Hamilton

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 28,346☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

James O. Skarsten
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Typed or printed name

972-385-8777

Telephone number

March 20, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: **Boubez et al.**

Serial No.: **09/758,112**

Filed: **January 3, 2001**

For: **Apparatus and Method for
Categorizing Services Using Canonical
Service Descriptions**

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Group Art Unit: **3624**

Examiner: **Hamilton, Lalita M.**

Attorney Docket No.: **RSW920000102US1**

36736
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By: _____

Dell Whitton
Dell Whitton

**REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program.

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Applicants request that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to IBM Corporation Deposit Account No. 09-0461.

REMARKS

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed December 19, 2005. The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

In the Final Office Action, the Examiner rejected Claims 1-31 under 35 U.S.C. § 102(e), as being anticipated by Patent Application Publication US 2002/0062265, to Poon. This rejection is respectfully traversed.

1. Teachings of Applicants' Invention

Applicants' invention is generally directed to a method and apparatus for categorizing services using a canonical service description. The application at page 3 teaches that a canonical service description designates minimum requirements for a service classified into a particular classification, and ensures that all services classified into the particular classification will "have a minimum level of functionality." Claim 1 recites the method of Applicants' invention as follows:

1. A method, in a data processing system, of registering services in a taxonomy, comprising:
 - receiving a registration request at the data processing system, the registration request including a service description and an identification of a category within the taxonomy in which the service is to be registered; (referred to hereinafter as "Feature (1)")
 - determining if the service description should be registered in the identified category based on a canonical service description associated with the category; (referred to hereinafter as "Feature (2)") and
 - registering the service description in the identified category using the data processing system if the determination is that the service description should be registered in the identified category. (referred to hereinafter as "Feature (3)")

It is seen that Claim 1 recites three claim elements or features, referred to hereinafter as Features (1) –(3), respectively, for convenience.

2. Teachings of Cited Poon Reference

Poon, as taught for example in the summary at page 1, paragraph [0006], provides an arrangement for facilitating user selection of item categories in a computerized auction. Item

categories and subcategories may be made accessible to a user over the Internet or the like. Initially, the user receives a list of available categories and selects one of them, as disclosed at paragraph [0029], page 50. The user may then be presented with a list of available subcategories related to the selected category. The user at his option can select one of the subcategories, in order to categorize the item in the auction.

A prior art reference anticipates a claimed invention under 35 U.S.C. § 102 only if every element of the claimed invention is identically shown in that single reference, arranged as they are in the claims. All limitations of the claimed invention must be considered when determining patentability. Applicants respectfully submit that Poon does not teach every element of the claimed invention, arranged as they are in Claim 1. More particularly, Applicants believe that Poon teaches none of the Features (1)-(3) of Claim 1.

3. Feature (1) of Claim 1 Distinguishes over Cited Reference

Element (1) of Claim 1 recites the feature of receiving a registration request that includes both a service description, and an identification of a category, within the taxonomy in which the service is to be registered. Thus, the registration request of Claim 1 includes two distinct and different elements or components.

In the Office Action, the Examiner cited only paragraph [0029] of Poon, at page 50, to show the above Feature (1) of Applicants' Claim 1. This paragraph teaches that a user selects a category from a list of available categories received from a server. The server then responds with a list of subcategories for the user selected category, if there are any such subcategories available. This process continues until there are no further subcategories. The user may then decide to use the final selected category or subcategory for item registration.

The cited paragraph of Poon does not teach or refer to any activity that could reasonably be characterized as "receiving a registration request". Moreover, Poon clearly fails to teach or suggest a registration request that includes both elements of Feature (1) of Claim 1. As emphasized above, Feature (1) requires both a service description and an identification of a category for registering the service. Poon, of course, is concerned with auction items, not service descriptions, and thus provides no teaching in regard to either service descriptions or identification of categories therefor. However, even if it is assumed that an auction item of Poon is equivalent to a service description of Claim 1, Poon still fails to teach a registration request that is received, and that includes both an auction item and an identification of a category for registering the item, as taught by Feature (1) of Claim 1.

Such teaching of Applicants' Claim 1 would, in fact, be contrary to the clear disclosure of the cited paragraph of Poon. Applicants' Claim 1 teaches that a user seeking to register a service description must provide both the description and an identification of a category. However, the cited paragraph [0029] emphasizes that it is the server, and not the user, that proposes or identifies categories and subcategories for registering the item.

4. Features (2) and (3) Distinguish over the Cited Art

Paragraph [0029] was also the only section of Poon cited against Feature (2) of Applicants' Claim 1. It is readily apparent, however, that paragraph [0029] fails to disclose the recitation of Feature (2), that is, determining if the service description should be registered in the identified category, based on a canonical service description associated with the category. In Poon, the server merely determines if there are related subcategories associated with a category selected by the user. In fact, nowhere in Poon is there any teaching of a canonical service description associated with a category, nor is there any disclosure of a comparable component. This is contrary to essential teachings of Applicants, which stress the importance of a canonical service description for providing a minimal level of assurance in regard to services classified thereby. Unlike Applicants, Poon is not concerned with ensuring a minimal level of classified services, as is achieved by use of the canonical service description of Claim 1. Poon has objectives that are unrelated to this concern. Accordingly, Poon would have no need for or interest in the canonical service description or related elements of Feature (2).

Moreover, the Final Office Action has proffered no analysis or explanation as to why the cited paragraph [0029] somehow anticipates determining whether the service description should be registered in the identified category, based on a canonical service description associated with the category, as required by Feature (2) of Claim 1.

Feature (3) of Claim 1 recites registering the service description in the identified category, if the determination is that the service description should be registered in the identified category. As discussed above, Poon does not disclose the "determination" of Feature (3), that is, determination that was based on the canonical service description associated with the identified category. In Poon, the server only determines if there are further subcategories for selection. The user then decides what category the item should be listed in.

5. Remaining Claims Distinguish Over the Cited Art

Independent Claims 11, 21, and 31 respectively incorporate subject matter similar to the subject matter of Claim 1, and are considered to patentably distinguish over the art for the same

reasons given in support thereof. Thus, Poon does not teach each and every feature of independent Claims 1, 11, 21, and 31, as is required under 35 U.S.C. § 102.

Claims 2-10, 12-20, and 22-30 depend from Claims 1, 11, and 21, respectively, and are each considered to patentably distinguish over the art for the same reasons given in support thereof. Additionally, Claims 2-10, 12-20, and 22-30 recite other additional combinations of features not suggested by the reference.

Poon does not teach, suggest or give any incentive to make the needed changes to reach the presently claimed invention. Accordingly, one of ordinary skill in the art would not be led to modify Poon to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion or incentive to modify Poon in this manner, the presently claimed invention can be reached only through an improper use of hindsight, using the Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

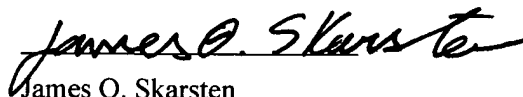
All remarks set forth in Applicants' Response to Office Action dated September 22, 2005, that distinguish Applicants' claims over Poon and are not expressly set forth herein, are incorporated herein by reference. This includes remarks pertaining to Claims 2-3, 5-10, 12-13, 15-20, 23 and 25-30.

In view of the above Remarks, Applicants consider that Poon fails to describe, teach or suggest all of the individual features of Applicants' claims, or the combination of features of Applicants' claims. Accordingly, Applicants' claims are patentable over the cited art and the application is in condition for allowance. Favorable action is respectfully requested.

The Pre-Appeal Brief Conference Panel is invited to call the undersigned at the below-listed telephone number if in the opinion of the Panel such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: March 20, 2006

Respectfully submitted,



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